

REMARKS/ARGUMENTS

In this Amendment After Final Under 37 C.F.R. § 1.116 (“Amendment After Final”), Applicants propose to cancel, without prejudice or disclaimer, claim 16. No new matter is introduced.

Prior to entry of the Amendment After Final, claims 2-17 were pending in the application. After entry of the Amendment After Final, claims 2-15 and 17 are pending in the application.

In the Final Office Action (“FOA”), the Examiner rejected claims 2-17 under 35 U.S.C. § 101; and rejected claim 16 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,206,827 to Tsuruta (“Tsuruta”).

Applicants respectfully traverse the Examiner’s rejection under 35 U.S.C. § 101.

Entry of Amendment After Final

Applicants submit that the proposed cancellation, without prejudice or disclaimer, of claim 16 does not raise new issues that would require further consideration and/or search, and does not raise the issue of new matter. Additionally, Applicants submit that the proposed cancellation, without prejudice or disclaimer, of claim 16 places the application in better form for appeal by materially reducing or simplifying the issues for appeal. Therefore, Applicants submit that this Amendment After Final should be entered and considered by the Examiner.

Incorporation of Previous Arguments by Reference

In addition to the arguments presented below, Applicants specifically incorporate by reference the arguments made in the Amendment Under 37 C.F.R. § 1.111 (“First Amendment”) filed on June 11, 2008.

Claim Rejection Under 35 U.S.C. § 102(b)

As discussed above, Applicants cancel, without prejudice or disclaimer, claim 16. Applicants submit that this cancellation obviates the rejection under 35 U.S.C. § 102(b).

Claim Rejection Under 35 U.S.C. § 101

Applicants submit that the FOA fails to establish a proper prima facie case that claims 2-15 and 17 are directed to non-statutory subject matter under 35 U.S.C. § 101 for at least the following reasons.

First, as the Examiner may be aware, the United States Court of Appeals for the Federal Circuit recently released its long-awaited en banc decision in In re Bilski. And that decision¹ appears to overrule at least the “useful, concrete and tangible result” analysis of State St. Bank & Trust Co. v. Signature Fin. Group, 47 USPQ2d 1596 (Fed. Cir. 1998) and AT&T Corp. v. Excel Communications, Inc., 50 USPQ2d 1447 (Fed. Cir. 1999). Thus, the In re Bilski decision completely undermines the FOA’s analysis—which is based on the “useful, concrete and tangible result” test of the State Street decision.

¹ In re Bilski, No. 2007-1130, slip op. at 20 (Fed. Cir. Oct. 30, 2008).

Second, the FOA does not allege that any of claims 2-15 and 17 fall outside of the four enumerated categories of patentable subject matter recited in 35 U.S.C. § 101 (process, machine, manufacture, or composition of matter).

Third, the FOA does not appear to allege that any of claims 2-15 and 17 fall within any of the three judicial exceptions to patentable subject matter (abstract ideas, natural phenomena, and laws of nature)—at least because the FOA does not appear to mention “judicial exception”, “abstract idea”, “natural phenomenon”, or “law of nature”, even though the FOA discusses the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” dated November 22, 2005 (“Interim Guidelines”).

Fourth, the FOA is logically inconsistent, at least because it alleges that “the claimed inventions fail to accomplish a practical application” in one sentence, but alleges that “the claims appear to cover every substantial practical application” in the very next sentence. FOA, p. 2, § 2.

Fifth, as discussed above, the FOA alleges that “the claims appear to cover every substantial practical application”. Id. However, the FOA does not “identify the abstraction, law of nature, or natural phenomenon and explain why the claim covers every substantial practical applications thereof”, as required by Section IV.C.3 of the Interim Guidelines.

Sixth, as discussed above, the FOA alleges that “the claims appear to cover every substantial practical application”. Id. However, each of claims 2-15 and 17 is directed to a multiple modulus selector (or Montgomery

modular multiplier or Booth recoder) of a computer system, communication network, or computer system and communication network. Further, each of claims 2-15 and 17 is directed to a multiple modulus selector (or Montgomery modular multiplier or Booth recoder) of a computer system, communication network, or computer system and communication network that uses a public-key cryptographic algorithm. Thus, for example, any computer system, communication network, or computer system and communication network that does not use a public-key cryptographic algorithm also does not fall within the literal scope of claims 2-15 and 17. For at least these reasons, Applicants submit that claims 2-15 and 17 do not cover every substantial practical application. And, as a result, Applicants submit that claims 2-15 and 17 cannot preempt a judicial exception under 35 U.S.C. § 101.

Because the FOA fails to establish a proper prima facie case that claims 2-15 and 17 are directed to non-statutory subject matter under 35 U.S.C. § 101, Applicants request that the rejection be withdrawn.

Request for Reconsideration and Allowance

Accordingly, in view of the above amendments and remarks, reconsideration of the rejections and allowance of each of claims 2-15 and 17 in connection with the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

If necessary, the Director of the U.S. Patent and Trademark Office is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; in particular, extension of time fees.

Respectfully submitted,

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By

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